

REMARKS

This is in response to the Office Action dated June 17, 2004, and the references cited therewith.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 2, 6, 8-11, 13-15, 23-26 and 30 remain pending in this application.

§103 Rejection of the Claims

Claims 2, 6, 8-11, 13, 14 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Brownlee et al. (U.S. Patent No. 4,134,408) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Donders et al. (U.S. Patent No. 6,115,635).

Applicant respectfully traverses the rejection and submits that *prima facie* obviousness has not been established. For example, Applicant submits that the Office Action has not set forth motivation sufficient to support the selection and combination of Brownlee, Silvian and Donders in the manner proposed.

As noted by M.P.E.P. § 2143.01, the prior art must suggest the desirability of the claimed invention. Here, the Office Action has not identified a specific teaching supporting the proposed combination. The Office Action refers to a "ferrite core in the Brownlee et al. system in order enable high transmission rates so data can be transferred without significant error while preserving limited power resources of the implanted device." In contrast to the Office Action assertion, Brownlee refers to an external system for "externally powering" (Abstract) and does not appear to refer to data telemetry. The presence of the phrase "radio frequencies" in column 2 does not support a conclusion that Brownlee teaches telemetry. Furthermore, the ferrite core appears in a discussion of Silvian with respect to an implanted device (see column 6). The Office Action has not identified a teaching of a ferrite core in an external device. Applicant is unable to find, in Brownlee, evidence of a concern for high transmission rates or low error rate. In addition, Applicant submits that to combine Brownlee and Silvian in the manner proposed would require a change in the principle of operation of one or the other. For example, Brownlee refers to an external energy transmitting source for selectively externally powering the pacer (Abstract) whereas Silvian refers to a telemetry system where the transmitter includes a titanium can and relies on the can for a filtering function (Abstract). Because Silvian refers to telemetry

communication and is silent as to energy transfer, and because Brownlee refers to energy transfer and is silent as to telemetry communication, it appears that each operates according to different principles. Pursuant to MPEP § 2143.01, if the proposed combination would change the principle of operation, then the teachings of the cited documents are not sufficient to establish prima facie obviousness. Here, it appears that the principles of operation differ, and thus, the proposed combination is improper.

Pursuant to M.P.E.P. § 2143.01, the mere fact that cited documents can be combined or modified does not render the resultant combination obvious unless the documents suggest the desirability of the combination. Here, the Office Action does not set forth evidence of a motivation to select, or combine Brownlee and Silvian in the manner proposed. Thus, it appears, the proposed combination of Brownlee and Silvian is improper.

Furthermore, Applicant submits that the proposed addition of Donders to Brownlee and Silvian is improper. Donders refers to an antenna for an implantable medical device that is outside of a hermetic canister (Abstract). In contrast to Donders, Silvian refers to a transmitter coil inside of a can with the can providing filtering (Abstract, FIG. 1). Thus, it appears that the proposed combination of Silvian and Donders is improper because it would render at least one of Silvian and Donders unsatisfactory for its intended purpose. (See M.P.E.P. § 2143.01). Applicant submits that to combine in the manner proposed would require a change in the principle of operation of either one or the other and would require substantial reconstruction and redesign.

Even if the requisite motivation were established, it appears that the proposed combination of Brownlee, Silvian and Donders does not teach or suggest all elements recited in the pending claims. For example, Applicant is unable to find, in the proposed combination a teaching of conductive wire wound in a substantially in common plane, as recited in claim 15. The Office Action has not identified an explicit teaching of this element in the cited documents.

Applicant repeats the request for clarification or withdrawal of the Office Action assertion referring to “powered magnetic material.” Applicant submits that such an assertion does not amount to a teaching or suggestion of a “ferrite powder” as recited in claim 6. Applicant requests clarification or withdrawal of the assertion.

Therefore, because all claim elements are not taught or suggested by the proposed combination and because the record does not evince the required motivation to make the proposed combination, Applicant respectfully submits that *prima facie* obviousness has not been established. Reconsideration and allowance of claims 2, 6, 8-11, 13, 14, and 15 is respectfully requested.

Claim 23 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Donders et al. (U.S. Patent No. 6,115,634). Applicant respectfully traverses the rejection because the Office Action fails to establish *prima facie* obviousness.

Applicant submits that the proposed combination is improper because evidence of motivation to pursue the proposed combination is not of record. As noted earlier, Weijand refers to an external programmer head (Abstract) and Silvian and Donders relate to implantable devices. The Office Action asserts that Weijand and Silvian are both directed to telemetry systems with coils associated with implantable devices and concludes that the references are deemed combinable. Applicant, on the other hand, disagrees and submits that membership in a class of telemetry systems does not necessarily mean that one member is combinable with another. For example, in the class of writing systems, it cannot be said that technology used in a pencil sharpener is properly combinable with technology used in pencil manufacturing without setting forth a genuine motivation to combine. Desirability of a proposed combination cannot be shown by merely asserting an ability to combine.

The Office Action characterizes Applicant's response in stating that "there is no suggestion to combine the references because the resultant invention would be unsatisfactory." This is not an accurate characterization of Applicant's argument. More precisely, it is Applicant's position that the teachings of the cited documents cannot be combined without changing the principle of operation of one or the other, thus necessitating substantial reconstruction or redesign of at least one of the cited documents. Because the principles of operation are different, the proposed combination is improper. Applicant makes no statement as to the suitability of, or satisfaction with, any resulting invention.

Applicant respectfully requests reconsideration and allowance of claim 23.

Claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Donders et al. (U.S. Patent No. 6,115,634) and further in view of Kung (U.S. Patent No. 6,400,991).

The Office Action asserts that the inductive transfer of energy and communications using telemetry coils is accepted practice in the implantable medical device, hence the references are deemed combinable. Applicant, however, respectfully traverses and notes that combinability alone does not equate to motivation to combine. The Office Action does not appear to set forth grounds for desirability of the proposed combination. Accordingly, Applicant submits that *prima facie* obviousness has not been established.

Claims 25 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Donders et al. (U.S. Patent No. 6,115,634) and further in view of Zarinetchi et al. (U.S. Patent No. 6,389,318). Applicant submits that *prima facie* obviousness has not been established.

Applicant is unable to find, in Zarinetchi, a citation to element 702/712. Furthermore, Applicant is unable to find, in Zarinetchi, support for the Office Action assertion that the insulation is the ferrite shield. The cited portions of Zarinetchi do not appear to refer to the ferrite shield in a manner consistent with the Office Action assertion. Applicant requests citation to supporting authority consistent with the Office Action assertions or withdrawal of the assertions.

The Office Action characterizes Applicant's response in stating that "there is no suggestion to combine the references because the resultant invention would be unsatisfactory." This is not an accurate characterization of Applicant's argument. More precisely, it is Applicant's position that the teachings of the cited documents cannot be combined without changing the principle of operation of one or the other, thus necessitating substantial reconstruction or redesign of at least one of the cited documents. Because the principles of operation are different,

the proposed combination is improper. Applicant makes no statement as to the suitability of, or satisfaction with, any resulting invention.

Applicant further submits that the Office Action assertion concerning combinability of the cited documents is not sufficient to establish the requisite motivation to combine. Accordingly, Applicant submits that *prima facie* obviousness has not been established.

Claim 30 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Stokes et al. (U.S. Patent No. 5,814,089). Applicant submits that *prima facie* obviousness has not been established.

The Office Action asserts that Stokes discloses a multi-element transmitter. Notwithstanding the absence of such a precise disclosure in Stokes, Applicant notes that claim 30 refers to a first and second telemetry coil concentrically planarly wound substantially in a common plane. Applicant is unable to find support for such an element in Stokes individually or in the proposed combination of cited documents. Furthermore, Stokes appears incapable of meeting the claim language recitation concerning different telemetry operational frequencies since Stokes appears silent as to the recited first and second telemetry coil.

Applicant notes that the Stokes title includes the word *leadless*. In contrast, the claimed subject matter refers to a communication lead. Applicant respectfully submits that Stokes cannot properly be modified or combined with another document to achieve the claimed subject matter without substantial reconstruction or redesign. Accordingly, the proposed combination appears to be improper.

Applicant further submits that the motivation stated in the Office Action is inadequate to support the selection and proposed combination of cited documents. The Office Action has not set forth the desirability of the proposed combination and thus, *prima facie* obviousness has not been established.

Conclusion

Applicant respectfully submits that the pending claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6911 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

October 18, 2004

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of October, 2004.

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